

**REMARKS**

Claims 1-10 are pending. Claims 5-10 have been withdrawn from consideration. Claims 1, 3 and 4 have been amended without narrowing their scope. Claims 1, 3 and 4 are the only independent claims under consideration.

The Office Action did not include an initialed copy of the form PTO/SB/08 that accompanied the Information Disclosure Statement dated April 26, 2004. It is requested that the Examiner initial and return the enclosed duplicate PTO/SB/08 with the next Office Action.

Claims 4 and 6 were objected to. As to claim 4, that claim has been amended, without narrowing its scope, to correct the obvious typographical error and change "receivers" to "receives." As to the query "what is ESCO?" ESCO stands for Energy Service COmpany, which is made quite clear in the specification at page 16, lines 4-7. Since the claims are intended to be interpreted after having read the specification, there is no issue as to what ESCO stands for. For this reason, the claim will not be amended at this time. As to the objection to claim 6, since that claim is withdrawn, it cannot currently be amended. Upon rejoinder after allowance of a generic claim, the claim will be amended at that time in the manner suggested by the Examiner.

Claims 1, 2 and 4 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite. In particular, the Examiner objected to the recitations using the term event and events. Applicant has amended these claims to some extent to improve the idiomatic English, without narrowing the claims. However, the specification makes quite clear what an event is, see page 2, lines 17-19, for example. Since the test for definiteness is defined in relation to a person having read the specification, the test would be met since one of ordinary skill in the art, after having read the specification, would be able to determine the scope of these claims. Withdrawal of the rejection is requested.

Claims 1, 2 and 4 were rejected under 35 U.S.C. § 103 over U.S. Patent 6,714,857 (Kapolka et al.) in view of JP 2002-197155 (Riu et al.) and U.S. Patent 6,636,790 (Lightner et al.). Claim 3 was rejected under 35 U.S.C. § 103 over Kapolka et al. in view of Riu et al. and Lightner et al. and further in view of U.S. Application 2002-089349 Satoshi et al. Applicant traverses.

With regard to claim 1, the Examiner conceded that Kapolka contains no teaching of the in-vehicle device providing data relating to engine revolutions, and vehicle speeds. Nor does Kapolka show storing the calculated information in the database with user information, retrieving and processing the information for a diagnosis by combining and comparing the information, providing the contents from the mail server to the user terminal. Further, Kapolka does not show that the user's terminal sets up timing of providing the contents and detail of the contents and informs with sound.

However, the Examiner has relied upon two other references to supply these features and argued that it would have been obvious to have combined all three in exactly the manner claimed. Riu is relied upon to supply certain features. The ones not supplied by Riu are alleged to be supplied by Lightner.

To establish a prima facie case of obviousness requires, among other things, that motivation in the prior art be identified that would cause one of ordinary skill in the art to make the proposed combination of references. In this case, since the rejection is based upon a combination of *three* references, there needs to be motivation identified to combine all three. It is not enough to provide motivation to combine the first two, and then say that in view of that combination, it would have been obvious to make the additional modification of the combination of the first two references.

In this case, however, no legally acceptable motivation has been provided at all, still less a motivation to combine all three references. It is not enough to simply state, as the

Office Action does, that it would have been obvious to combine the references “in order to track working conditions of a specific vehicle and to monitor the amount emission to facilitate limiting pollution to the environment.” This is simply saying it would have been obvious because “then you would have the claimed invention,” which is not a proper motivation.

To support such a combination requires a showing that the prior art itself somehow provides a motivation to combine these three references in exactly the manner claimed. As discussed above, no motivation to combine *any* of the references with any other has been provided, and of course even that would not have been sufficient, as discussed above.

If this rejection is to be maintained, the Examiner must provide some motivation for the proposed three-way combination, and not simply a statement that the combination would be obvious because the combination would yield all the claim limitations, which is what was done in this Office Action.

For at least the reasons set forth above, the Examiner has failed to establish a prima facie case of obviousness for claims 1, 2 and 4.

The rejection of claim 3 is even more deficient since the Examiner has completely failed to provide motivation for a combination of *four* references. Moreover, the Examiner improperly took the combination of the first three references as a given in explaining the further modification based on Satoshi. This is improper since motivation must be shown to combine *all four references*. The combination of the first three references cannot be treated as a given since no reference actually exists that has the features of this hypothetical construct. For at least this additional reason, no prima facie case has been made in connection to claim 3.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

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